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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,636	10/28/2003	Mark A. Tapsak	DEXCOM.028A	5384
20995	7590	05/22/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			MOORE, MARGARET G	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			1712	

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/695,636

**Applicant(s)**

TAPSAK ET AL.

**Examiner**

Margaret G. Moore

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 to 26, 135 to 139 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 26, 135 to 139 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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1. Claims 1 to 26 and 135 to 139 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The negative proviso "that the silicone composition is not produced from a precursor comprising diisocyanate" is not supported by the specification. Please note that the mere absence of a positive recitation is not basis for an exclusion..

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 to 12, 17 to 26, 138 and 139 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy.

This rejection relies on the rationale of record and as such this will not be repeated. As noted previously, this membrane is permeable to water, hydrocarbons and oxygen and meets the "configured to control transport of an analyte..." limitation.

Applicants traverse this rejection by stating that Kennedy does not disclose this requirement. It is argued that permeability does not imply that the material will control the transport of an analyte. In applicants' response they appear to give the phrase "control the transport" the meaning of "diffusion resistance" (see the e.g. comment on the second and third to the last lines on page 5 of the response). The Examiner does not agree that the term "control" is so limiting. Note for instance the definitions of control in the attached Webster's Dictionary citation. Definition 1) means to regulate. By being permeable to water, hydrocarbons and oxygen the membrane of Kennedy regulates the transport thereof. On the other hand, if the membrane is permeable to these substances it regulates or does not allow for the transport of other materials, those for which the membrane is not permeable. In addition see definition 4) of control, which means directing influence over. Allowing certain materials to permeate indicates that others cannot permeate and thus the membrane of Kennedy has influence over, or

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controls, the transport of these materials, or analytes. This applies to new claim 139 in that, regardless of whether the membrane is permeable to glucose or not, the membrane will control the transport.

Giving the term "control" the broadest reasonable interpretation, one could consider a membrane to control transport of an analyte either by allowing the analyte to pass through or by not allowing it to pass through.

For these reasons applicants' traversal is not persuasive. Applicants argue that the requirements of claims 135 and 136 are not anticipated by Kennedy for additional reasons, but the Examiner notes that no "additional" reasons are necessary. These claims depend upon claim 13 which was not rejected over Kennedy.

4. Applicants' amendment overcomes the rejection over Antwerp '060. As noted above, though, this amendment is not supported by the specification.

5. Claims 1 to 5, 7, 8, 10, 11, 17 to 19, 138 and 139 are rejected under 35 U.S.C. 102(e) as being anticipated by Al-Lamee.

This rejection relies on the rationale of record and as such this will not be repeated. The Examiner refers to the position made in paragraph 3, *supra*, as it applies to the phrase "control transport of an analyte". Note that the teachings in Al-Lamee are drawn to membranes formed on oxygenators, which have oxygen permeability, blood filters and glucose monitoring devices (which immobilize or control the transport of glucose). See paragraphs 18 and 22.

Again no arguments are necessary for claims 135 to 137 as these claims depend upon a claim that was not included in this rejection.

6. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Al-Lamee.

This rejection relies on the rationale of record. Applicants rely on the alleged novelty of claim 1 in overcoming this rejection. Since this is not persuasive this rejection is maintained.

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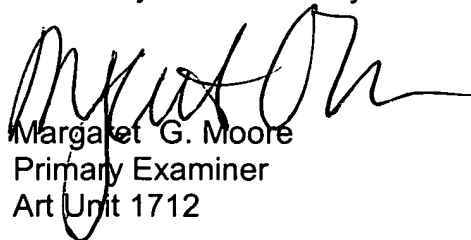
7. Claims 1 to 12, 17, 19 to 26, 138 and 139 are rejected under 35 U.S.C. 102(b) as being anticipated by Keogh et al.

This rejection relies on the rationale of record and as such this will not be repeated. The Examiner refers to the position made in paragraph 3, supra, as it applies to the phrase "control transport of an analyte". By transporting oxygen (see the abstract of Keogh et al.) the membranes therein control the transport of oxygen.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

  
Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
5/17/06